No. 95-26

IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

HERBERT MARKMAN and POSITEK, INC.,

Petitioners,

—v.—

WESTVIEW INSTRUMENTS, INC. and
ALTHON ENTERPRISES, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* and *AMICUS CURIAE* BRIEF OF THE AMERICAN BOARD OF TRIAL ADVOCATES IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

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MOTION FOR LEAVE TO FILE BRIEF OF *AMICUS CURIAE* AMERICAN BOARD OF TRIAL ADVOCATES IN SUPPORT OF PETITIONERS

Amicus Curiae American Board of Trial Advocates ("ABOTA") moves for leave to file the accompanying brief in support of the petition for a writ of certiorari. Petitioners have consented to ABOTA's filing of a brief *amicus curiae*, but respondents have refused consent.

ABOTA is a national organization of trial lawyers composed equally of defense and plaintiffs counsel. Its primary purpose is to preserve the constitutional right to trial

by jury. It is dedicated to promoting the fair and efficient administration of justice. It has no interest in any of the parties to this action.

ABOTA is very concerned about the consequences of the Federal Circuit's decision. By reclassifying fact as "law," the Federal Circuit has taken important fact issues out of the hands of juries in actions at law for money damages for patent infringement. It has also stripped the trial court's fact determinations of the deference they deserve on appeal, and substituted *de novo* review in place of that deference. The reasons that this Court should review this decision are discussed in the accompanying brief.

As a national organization of trial lawyers, ABOTA brings an important perspective to this case. ABOTA believes that its views could aid this Court in deciding whether to grant the petition for a writ of certiorari. It therefore requests permission to file the accompanying brief.

Respectfully submitted,

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AMICUS CURIAE BRIEF OF THE AMERICAN BOARD OF TRIAL ADVOCATES IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

Interest of *Amicus Curiae*

The American Board of Trial Advocates (ABOTA) is a national organization whose members include 4,200 trial lawyers. ABOTA's primary purpose is to preserve the Constitutional right to a jury trial. It is dedicated to promoting the fair and efficient administration of justice.

ABOTA has no interest in any of the parties or in which side ultimately wins this lawsuit. Its only interest is in the important issues that this case raises, concerning: (a) the right to trial by jury, and (b) the respective roles of trial and appellate courts.

Summary of Argument

Unless reviewed by this Court, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), would signal a major departure from fundamental principles of American jurisprudence. First, it ousts juries from their constitutionally protected role as finder of fact in actions at law for money damages for patent infringement. Second, it assigns the court of appeals a new and unprecedented role as *de novo* fact finder, with free rein to substitute its own findings in place of those made in the trial court.

In both respects, *Markman* upsets the institutional balance that is the bedrock of our legal system. It is a drastic departure from basic principles. It warrants this Court's review.

To oust juries from their fact finding role, *Markman* uses the simplest of expedients: It "redesignat[es] fact as 'law.'" *Id.*, 52 F.3d at 999 (Newman, J., dissenting).

Markman's reclassification of fact as "law" has sweeping ramifications. Judge Mayer of the Federal Circuit stated that *Markman* "jettisons more than two hundred years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment." *Markman*, 52 F.3d at 989 (Mayer, J., concurring in the result). He also described the decision as a "sea change in the course of patent law that is nothing short of bizarre." *Id.* As Judge Newman stated in dissent, the decision "moves the Federal Circuit firmly out of the juridical mainstream," and "raises a constitutional issue of grave consequence." *Id.*, 52 F.3d at 999, 1026 (Newman, J., dissenting).

Because of the Federal Circuit's unique jurisdiction, this decision will govern all patent cases, everywhere in the

country. *Markman* also has unfortunate implications outside the patent arena. It reflects a belief, shared by all too many, that juries should not be entrusted with important or complex issues. This view runs afoul of the framers' decision embodied in the Seventh Amendment to provide a constitutional right to trial by jury.

This Court should grant certiorari to preserve the Seventh Amendment right to trial by jury and to maintain the appropriate balance between trials and appeals.

ARGUMENT

I. The Federal Circuit Should Not Be Allowed To Subvert Seventh Amendment Rights By Reclassifying Fact As "Law"

The language in patent claims is not written for judges or lawyers. It often is technical, scientific language, and it is written for persons trained in the relevant technology or "art." The aim of claim construction is to ascertain how persons skilled in that field would understand the claim language.[1]

Prior to *Markman*, courts could construe claim language as a matter of law if the underlying facts were not genuinely in dispute.[2] But where conflicting evidence raised a genuine fact issue, then claim construction presented issues for the trier of fact.[3] In such cases, the fact finder's

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1 *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 867 (Fed. Cir. 1985).

2 *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989).

determinations received appropriate deference once the case reached the appellate court.[4]

Markman changes all that. By reclassifying fact as law, it takes all claim interpretation issues away from the jury. It does so even where conflicting evidence, including expert testimony, presents a genuine factual dispute on how persons skilled in the relevant technology would understand the language appearing in the claims.

By way of example, the following issues of claim interpretation -- all treated under prior cases as presenting

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3 *See, e.g., Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993); *Lemelson v. General Mills, Inc.*, 968 F.2d 1201, 1206-07 (Fed. Cir. 1992), *cert. denied*, 113 S. Ct. 976 (1993); *Tol-O-Matic, Inc. v. Proma Produkt-und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991); *Johnston*, 885 F.2d at 1579; *Snellman v. Ricoh Co.*, 862 F.2d 283, 287-88 (Fed. Cir. 1988), *cert. denied*, 491 U.S. 910 (1989); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984).

4 *See, e.g., Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1568-69 (Fed. Cir. 1992) (appeal from jury verdict); *Smithkline Diagnostics Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988) (appeal from bench trial).

issues of fact -- would now become issues of law under *Markman*:

- how an electrical engineer skilled in semiconductor chip technology would understand "distributed capacitances [in the MOS transistor] being charged during the state of non-conductivity in the first transistor."[5]

- how persons skilled in the packaging of medical products would understand "a storage stable sterile synthetic surgical element of a polymer subject to hydrolytic degradation to non-toxic, tissue-compatible absorbable components."[6]

- the meaning of "first electrical comparator connected to the load measuring means measuring the polished rod load relative to a preset load point" to an engineer skilled in designing fluid pumps.[7]

- how people skilled in technology for converting video signals for display would understand "non-interlaced raster frame buffer

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5 *Brooktree*, 977 F.2d at 1572-73.

6 *American Cyanamid Co. v. United States Surgical Corp.*, 30 USPQ2d 1561, 1563 (D. Conn. 1993).

7 *Delta-X*, 984 F.2d at 414-15.

... for storing the video signal at a second scan rate differing from the first scan rate."[8]

- how persons skilled in the art of optical lens design would understand "selectively operating the sputter cathode device to deposit a layer of the selected material on the substrate; and selectively operating the ion source device in sequence with the sputter cathode device for substantially completing the selected reaction during a single pass of the carrier."[9]

- the meaning of "human leukocyte interferon as a homogeneous protein species" to persons skilled in genetic research.[10]

- the meaning, to those skilled in the processes for dehydrating and preserving liposomes, of the phrase "mixing a hydrophylic compound with the colloidal dispersion of lipsomes in an aqueous medium."[11]

This Court should ask itself whether it would be in a position to rule on the above issues as a matter of law,

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8 *RasterOps v. Radius, Inc.*, 861 F. Supp. 1479, 1483 (N.D. Cal. 1994).

9 *Optical Coating Laboratory, Inc. v. Applied Vision, Ltd.*, 1994 WL 361752, *4 (N.D. Cal. 1994).

10 *Hoffman-LaRoche Inc. v. Burroughs Wellcome Co.*, 10 USPQ2d 1602, 1605 (D.Md. 1989).

11 *Liposome Co., v. Vestar, Inc.*, 1994 WL 738952 (D. Del. 1994).

knowing that experts have offered diametrically opposed testimony on how persons skilled in the relevant technology would understand the disputed language. Unless this Court could decide such issues as a matter of law, there is something seriously wrong with the *Markman* decision.

What is wrong, plainly and simply, is that such questions are not issues of law in any realistic sense. They are not issues in which judges have training or expertise. They involve real world facts, concerning the state of mind of persons skilled a particular technology. They have importance only to particular litigants -- just as the construction of a deed (which demarcates the boundaries of real property) has inportance only to particular litigants. They do not involve broad legal principles of general applicability.

The *process* by which such issues are decided is not the *process* by which courts decide issues of law. The meaning of claim language to a person skilled in a particular technology, when seriously in dispute, cannot be discovered by reading briefs or hearing oral argument. It must be determined by evaluating evidence, including the testimony of experts.

Markman itself recognizes that extrinsic evidence -- including expert testimony -- is often needed to ascertain how persons skilled in the particular technology would understand disputed claim language. *See, Markman*, 52 F.3d at 979, quoting *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1027 (1988) ("Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used.").

When the testimony of experts conflicts -- and it often does -- then someone needs to decide which aspects of the testimony to accept, which to reject, and what weight the

testimony deserves. This requires application of the tools that traditionally are used to assess the credibility of witnesses. It requires fact-finding.

Markman pretends that is not the case. It insists that the decision to "us[e] certain extrinsic evidence . . . and reject[] other evidence" does "*not* [entail] crediting certain evidence over other evidence or making factual evidentiary findings." *Markman*, 52 F.3d at 981. That assertion denies reality. It is an exercise in "sophistry and fiction." *Lucas Aerospace, Ltd. v. Unison Indus., L.P.*, ___ F. Supp. ___, 1995 WL 362397, *12 n.7 (D. Del. 1995) (criticizing *Markman*).

The rationales cited in *Markman* to support the reclassification of fact as "law" cannot withstand scrutiny. The court summarized the basis for its holding as follows:

> The reason that the courts construe patent claims as a matter of law and should not give such task to the jury as a factual matter is straightforward: It has long been and continues to be a fundamental principle of American jurisprudence that "the construction of a written evidence is exclusively with the court." *Levy v. Gadsby*, 7 U.S. (3 Cranch) 180, 186 (1805) (Marshall, C.J.).

But the principle that *Markman* describes as "fundamental" is flatly at odds with Rule 52(a), Fed. R. Civ. P., which recognizes that construction of a written document may present issues of fact.[12] It is also at odds with this Court's

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[12] Rule 52(a) states in pertinent part that "[f]indings of fact . . . based on . . . documentary evidence, shall not be set aside unless clearly erroneous . . . ."

holding in *Anderson v. City of Bessemer, N.C.*, 470 U.S. 564 (1985), that appellate courts must defer to the trial court's findings of fact, including fact findings that are based on "documentary evidence." *Id.*, 470 U.S. at 574. Under Rule 52(a) and under *Anderson*, it is simply wrong to say that construction of a written document is invariably an issue of law.

In fact, construction of written documents often presents issues of fact. Courts have long recognized this principle in contract cases, when they apply the hornbook rule that "[w]here the meaning of a writing is uncertain . . . the question of its meaning should be left to the jury." Vol. 4 Williston on Contracts, § 616, at p. 652 (1961).[13] Until *Markman*, courts followed the same principle in construing disputed language in patent claims.[14]

Markman rejects the analogy to contract cases. *Id.*, 52 F.3d at 985. But it never offers a meaningful distinction between contracts and patents.

First, *Markman* tries to distinguish contract cases by stating that interpretation of a contract depends on the parties' "intent," whereas the intent of the PTO or the patentee is irrelevant in construing patent claims. *Id.* This misses the point. Certainly, different issues arise in interpreting contracts

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[13] *See also, United States Naval Institute v. Charter Communications, Inc.*, 875 F.2d 1044, 1048 (2d Cir. 1989); *Cunningham & Co. v. Consolidated Realty Mgt., Inc.*, 803 F.2d 840, 842-43 (5th Cir. 1986).

[14] *See e.g.*, cases cited in fn. 3, *supra*.

and patents -- but where those issues are genuinely in dispute, then fact issues arise for a jury to resolve.

Second, *Markman* distinguishes contract cases from patent cases by stating that ambiguity in contracts may present fact issues, but "ideally there should be no 'ambiguity' in claim language. . . ." *Id.*, 52 F.3d at 986. Again, this misses the point. Contracts, like patent claims, also should "ideally" be unambiguous. But in both contracts and patents, this ideal is not always achieved. Indeed, "a clear and unambiguous [patent] claim [is] a rare occurrence." *Autogiro Co. of Amer. v. United States*, 384 F.2d 391, 396 (Ct. Cl. 1978). When experts offer diametrically opposed testimony on what "ideally" unambiguous claim language would mean to persons skilled in the art, then interpretation of that language is a fact issue for the jury.

To be sure, complex issues may arise in determining how persons skilled in a particular technology would understand technical language. But "mere complication of the facts" does not turn fact into law or justify taking the issue away from the jury. *Curriden v. Middleton*, 232 U.S. 633, 636 (1914). This Court has never adopted a "complexity" exception to the right to trial by jury. Nor could it adopt such an exception consistent with the framers' decision to enact the Seventh Amendment, notwithstanding Alexander Hamilton's assertion that juries should not be entrusted with complex issues. *See*, J. Guinther, The Jury in America, in *The American Civil Jury* 45, 55 (M. Arnold, ed.) (1986); A. Hamilton, *The Federalist*, No. 83, pp. 569-570 (J. Cooke, ed.) (1961).

At bottom, the Federal Circuit seems to be motivated less by precedent and more by a policy preference for having judges -- and ultimately, the specialist, patent law judges on the Federal Circuit -- decide the meaning of patent claims.

See, *Markman*, 52 F.3d at 979. Regardless of whether this policy is wise or unwise -- *amicus* believes it is unwise in the extreme -- it is at odds with the Seventh Amendment. As Judge Mayer stated:

> The quest to free patent litigation from the "unpredictability" of jury verdicts, and generalist judges, results from insular dogmatism inspired by unwarranted elitism; it is unconstitutional.

Markman, 52 F.3d at 989 (Mayer, J.). This Court should not permit the Federal Circuit to subvert the constitutional right to jury trials by the "ruse" (*Markman*, 52 F.3d at 993 [Mayer, J.]) of reclassifying fact as "law."

II. The Federal Circuit Should Not Be Allowed To Skew The Relationship Between Trial And Appeal By Making Itself A *De Novo* Finder Of Fact

Markman not only invades the province of juries, but also obliterates the deference due to fact-based determinations made on the evidence at trial. It distorts the entire relationship between trials and appeals.

Instead of deferring to the trial court's findings, the Federal Circuit gives itself the power and responsibility for deciding facts *de novo*. It does so without deference to anything that happened in the trial court, and without regard to whether the initial fact-finder was a judge or a jury. *See Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 810-11 (1986) (*per curiam*).

This flies in the face of repeated admonitions from this Court that appellate courts "must constantly have in mind that their function is not to decide factual issues *de novo*." *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 395 U.S. 100, 123 (1969).[15] It "usurps a major part of the functions of both trial judge and jury in patent cases, obliterating the traditional, defined differences between the roles of judge and jury, and trial and appellate courts." *Markman*, 52 F.3d at 992 (Mayer, J.).

Appellate courts may not reverse the trial court's factual determinations merely because they "would have decided the case differently." *Anderson*, 470 U.S. at 573. Yet that is precisely what the Federal Circuit now intends to do.

The finder of fact at trial, whether it is a judge or a jury, has advantages that appellate courts do not possess. The finder of fact sees and hears the live witnesses. It perceives nuances that cannot be captured in a cold record. It may see demonstrations that cannot be duplicated in that record. It lives with the evidence day in and day out. It enjoys an intimacy with the trial proceedings that an appellate court cannot match. The advantages that trial courts have in such matters are especially pronounced in patent litigation, "where the evidence is largely the testimony of experts enlightened by scientific demonstrations." *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 274 (1949).

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15 *Accord: Anderson*, 470 U.S. at 573; *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982); *United States v. National Ass'n of Real Estate Bds.*, 339 U.S. 485, 495-96 (1950); *United States v. Yellow Cab Co.*, 338 U.S. 338, 342 (1949).

Our system wisely recognizes the trial court's unique advantages in finding facts. In jury trials, it requires the court of appeals to defer to the jury's fact findings so long as they are supported by substantial evidence that reasonable jurors could accept.[16] In bench trials, it requires appellate courts to defer to the trial judge's findings unless they are "clearly erroneous."[17] In both instances, the guiding principle on appeal is deference to determinations that are based on the evidence at trial.

Markman destroys that deference. As Judge Mayer stated, *Markman* reduces trials to "a charade, for notwithstanding any trial level activity, [the Federal Circuit] will do pretty much what it wants under its de novo retrial." *Markman*, 52 F.3d at 993 (Mayer, J.). By making the Federal Circuit the *de novo* finder of fact, *Markman* turns the "trial judge and jury [into] ciphers upon appellate review." *Id.*, 52 F.3d at 1008 (Newman, J.).

As an appellate court, the Federal Circuit has two legitimate roles when an appeal raises issues concerning disputed claim construction. The first role involves evaluating the instructions under which the jury construed the claims, to make sure that the instructions correctly summarized neutral

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16 *See, Tennant v. Peoria & Pekin Union R. Co.*, 321 U.S. 29, 35 (1944); *Gallick v. Baltimore & Ohio R. Co.*, 372 U.S. 108, 114-15 (1963). *See also*, Rule 50(a)(1), Fed. R. Civ. P.

17 *See, Inwood Laboratories*, 456 U.S. 844, 853; *Anderson*, 470 U.S. at 564. *See also*, Rule 52(a), Fed. R. Civ. P.

legal principles so that the jury had accurate guidance in applying the law to the facts presented.[18]

The second role is to determine whether the findings at trial, when challenged on appeal, are supported by substantial evidence (in jury trials) or are clearly erroneous (in bench trials). This provides an adequate safeguard against the danger of irrational or clearly erroneous results, while at the same time recognizing that the fact finder is better situated for deciding fact issues than the court of appeals.

The Federal Circuit fulfills its appropriate role when it determines whether fact findings are supported by substantial evidence or are clearly erroneous. It seriously oversteps that role when it substitutes its own views in place of supportable, rational determinations made by the finder of fact based on the evidence at trial. *Anderson*, 470 U.S. at 573. That result, as Judge Mayer stated, would transform the trial from "'the main event' . . . [into] 'a tryout on the road.'" *Markman*, 52 F.3d at 992, quoting *Anderson*, 470 U.S. at 575.

The Federal Circuit's stated intention to review fact determinations *de novo* is a direct affront to this Court's decisions in *Zenith Radio Corp. v. Hazeltine Research*, 395 U.S. 100, *Anderson*, 470 U.S. 564, and other cases emphasizing the deference that is due to trial courts' fact determinations. It is a serious departure from the proper role of an appellate court.

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18 *See e.g.*, Guide To Jury Instructions In Patent Cases (American Intellectual Property Law Ass'n, 1990), p. 9.

III. *Markman* Would Create An Impractical, Unworkable System For Jury Trials And Appeals

Markman is not only wrong. As Judge Newman has stated, it is "unworkable," *id.*, 52 F.3d at 999 -- both at the trial level and on appeal.

In trials of patent infringement cases where a jury has been demanded, *Markman* creates a procedural nightmare. Under *Markman*, claim construction in jury trials could be handled in one of two ways: The first way would be for the trial judge to determine claim construction before the jury trial begins. This would require a separate "*Markman* hearing," which could last days or even weeks.

This would unduly burden the parties and the courts. Bifurcation of patent infringement cases into separate phases, *e.g.*, for liability and damages, already is "routine practice." *Eaton Corp. v. Auburn Gear, Inc.*, 8 USPQ 1373, 1374 (N.D. Ind. 1988).[19] Adding a separate *Markman* hearing would make *trifurcation* of patent cases the norm. What is more, much of the evidence in such a hearing would duplicate evidence that would need to be introduced in later phases on validity or infringement. The result would be increased burdens on the parties and on the courts.

Moreover, the alternative to pretrial *Markman* hearings is just as uninviting. That alternative would be for

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19 The Federal Circuit has strongly recommended bifurcation where the attorney-client privilege is asserted in cases charging willful infringement, as is often the case. *See, Quantum Corp. v. Tandon Corp.*, 940 F.2d 642, 643-44 (Fed. Cir. 1991).

the district judge and the jury simultaneously to hear all the evidence, including expert testimony, with the trial court to adopt one side's claim construction and reject the other side's in "framing its charge to the jury. . . ." *Markman*, 52 F.3d at 981.

If trial courts were to follow this path, litigants would have to tailor their evidence to address two conflicting theories of claim construction, knowing that at the close of the evidence the trial judge will reject one side's construction and adopt the other's. Of course, the party whose claim construction is rejected would suffer almost insurmountable prejudice. That prejudice could not be cured by an instruction directing the jury that the trial judge's agreement with the testimony of one side's experts on claim construction does not signify that the trial judge agrees with testimony by that expert on other issues, such as validity or infringement.

Even leaving aside the issue of prejudice, having the trial court decide claim construction at the close of the evidence as a matter of law would pose serious procedural problems. As the district court stated in *Lucas Aerospace*, 1995 W.L. at *1 n.3:

> . . . *Markman* creates a practical problem in courtroom administration that the Court confessedly does not know how to solve: How does the Court construe claims as a matter of law at the close of evidence without disrupting the jury? . . . To construe claims before giving the case to the jury requires immediate access to the trial transcript . . ., rapid briefing by the parties, and hopefully an opinion by the court. . . . [I]f the jury were sent home during this period, there is a very real chance that many of

> the facts important to resolving the infringement issues will have been forgotten.

Markman would be no less problematic on appeal. As discussed in Point II, *supra*, "[t]he appeal is not designed for *de novo* finding of the facts." *Markman*, 52 F.3d at 1025 (Newman, J.). Reading appellate briefs and listening to thirty minutes of oral argument are poor substitutes for the trial court's intimacy with the facts of any particular case. *Id.* at 999, 1021 (Newman, J). It is far from clear how the court of appeals will decide which expert's testimony to accept and which expert's testimony to reject, when it never sees live witnesses and cannot evaluate their credibility. That is a task for which the court of appeals is not well-suited. It is one where deference to the trial court is appropriate -- and is mandated by this Court's prior decisions.

CONCLUSION

For the reasons set forth above, this Court should grant the petition for a writ of certiorari.

Respectfully submitted,

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